

REMARKS/ARGUMENTS

On page 2 of the Official Action, claims 76 and 78 were rejected under 35 U.S.C. 102(b) as being anticipated by Hidary U.S. 5,852,775. In reply, applicant respectfully traverses.

“For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference.” Diversitech Corp. v. Century Steps, Inc., 7 U.S.P.Q.2d 1315, 1317 (Fed. Cir. 1988), quoted in In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990) (vacating and remanding Board holding of anticipation; the elements must be arranged in the reference as in the claim under review, although this is not an *ipsis verbis* test).

Applicant respectfully submits that Hidary does not disclose or suggest “processing the position location data to determine when the position location data indicates that the wireless communication device becomes in proximity to a certain location ... for transmitting the advertisement to the wireless communication device in response to the processing of the position location data determining that the wireless communication device has become in proximity to the certain location ...” (Applicant’s independent claim 76, lines 6-8 and 13-14.) Instead, transmission of an advertisement in Hidary is initiated by a subscriber indicating (either positively or through inaction) that he wishes to receive a message; e.g., when the subscriber initiates a wireless call or receives a wireless call. See Hidary step 100 in FIG. 3, step 200 in FIG. 4, and Col. 1 line 57 to Col 2 line 2; Col. 3 lines 1-3; col. 4 lines 26-31. Col. 5 lines 2-4; Col. 6 lines 54-57.

To further distinguish Hidary, new claims 88-92 are presented in order to particularly point out how applicant's preferred embodiment determines when the position location data indicates that the wireless communication device becomes in proximity to a certain location. New independent claim 88 is the same as claim 76 except that new claim 88 further specifies "a processor for receiving the position location data from the position location system and for processing the position location data by repetitively comparing successive ones of the positions of the wireless communication device, as indicated by the position location data, to a certain location to determine when the position location data indicates that the wireless communication device becomes in proximity to the certain location ...". Support for this additional limitation is found in applicant's FIG. 6 and in particular the looping back to step 90 from step 102 as described in applicant's original specification on page 9 lines 16 to 33 and in particular page 9 lines 30-32. In a similar fashion, this additional limitation is found in applicant's provisional application 60/255331 in applicant's FIG. 3 as described on page 5 lines 4-21 especially page 3 lines 13-16 and page 5 lines 9-10 and 18-20. See also applicant's laboratory notebook page 33 dated March 5, 2000 especially "(repetitive)" to the right of the sequence of the two steps including "User's actions/trends stored in memory" followed by "User notified if x in location y". Applicant's new claims 89-92 are the same as pending claims 77-80 except new claims 89-92 are dependent upon new claim 88 instead of claim 76. Therefore, new claims 89-92 are supported in the same fashion as pending claims 77-80 and distinguish the applied references for the same reasons as claims 77-80 as further discussed below.

On page 4 of the Official Action, claim 77 was rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary U.S. 5,852,775 and further in view of Owensby U.S. Patent 6,647,257. In reply, applicant respectfully traverses. Although Owensby discloses use of the Global Positioning System (Owensby col. 12 lines 30-36; claim 34) to determine the true geographical location of a subscriber's wireless mobile terminal to a degree of precision, neither Hidary nor Owensby discloses "processing the position location data to determine when the position location data indicates that the wireless communication device becomes in proximity to a certain location ... for transmitting the advertisement to the wireless communication device in response to the processing of the position location data determining that the wireless communication device has become in proximity to the certain location ...". Instead, Owensby teaches "a need will exist for a means of reducing subscriber service charges while maintaining operator profit margins" (col. 2, lines 28-3), and Owensby addresses this need by "inserting commercial information or advertisements before and during C/PCS and GMPCS communications that are targeted to the subscriber of the service." (Col. 4, lines 11-15.) "The messages to be targeted to the subscriber are chosen from the pre-selected messages, in a manner to be described hereinafter, at the time that a wireless mobile communication is initiated or received by a wireless mobile terminal." (Col. 4, lines 39-43.)

As discussed above, the advertisements of Hidary also are also transmitted when a subscriber initiates a wireless call or receives a wireless call. Hidary also is directed to reducing the high cost of individuals using a cellular telephone system by having advertisers pay the carrier for the right of integrating advertisement material with normal telephone communications. (Hidary, col. 1, lines 15-27.) Because neither Hidary nor Owensby discloses

the applicant's particular timing of advertisement transmission, and each of Hidary and Owensby appears entirely satisfactory for their common objective of having an advertiser subsidize a wireless mobile communication initiated or received by a wireless mobile terminal, the applicant's invention would not have been obvious from Hidary and Owensby.

In addition, the applicant's particular timing of advertisement transmission offers substantial advantages over the method of Hidary and Owensby. By broadcasting an advertisement when the user of the wireless communication device becomes in proximity to a certain location of interest to the user, the user does not need to wait for a communication to be initiated or received in the normal course of wireless telephone communications, nor does the user need to place a call to obtain the most current information. Instead, the applicant's invention permits a custom advertisement for the user to be quickly broadcast based on business conditions when the user of the wireless communication device becomes in proximity to a certain location of interest to the user. (See applicant's specification, page 6 lines 30-36; page 7 lines 23-29; page 8 lines 34-36.)

When determining whether a claim is obvious, an examiner must make "a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art." In re Ochiai, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, "obviousness requires a suggestion of all limitations in a claim." CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing In re Royka, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court stated, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR Int'l v.

Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)). A fact finder should be aware of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning. See Id., 127 S. Ct. at 1742, citing Graham, 383 U. S. at 36 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into the use of hindsight.”).

On page 5 of the Official Action, claims 79-80 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary U.S. 5,852,775 and Owensby U.S. Patent 6,647,257 and further in view of Taylor U.S. Patent 5,530,232. In reply, applicant respectfully traverses. Applicant respectfully submits that Taylor does not disclose the elements of the base claim 76 that are missing from Hidary and Owensby, nor does Taylor provide sufficient motivation for modifying the proposed combination of Hidary and Owensby to reconstruct the applicant’s invention of the base claim 76. Moreover, the environment and problem addressed by Taylor is substantially different from the environment and problem in Hidary and Owensby, so that a person of ordinary skill, dealing with the environment and problem of Hidary and Owensby, would not be looking at Taylor to modify Hidary and Owensby in the proposed fashion to reconstruct the invention of applicant’s claims 79-80.

Taylor discloses a multi-application data card capable of substituting for a plurality of existing single-application data cards. The multi-application data card can be a smart card comprising a memory formed with at least three memory banks or storage areas for storing and updating data relating respectively to at least one authorized holder of the card and at least two authorized applications of the card. Alternatively, the data card can be a conventional card

having a magnetic stripe, and the memory functions can be performed at a location remote from the card reader and connected thereto by a data link. In addition, the data card can comprise both a magnetic stripe and solid-state circuitry so that it can be read by a card reader compatible with a magnetic-stripe card or by a card reader compatible with a smart card. In accordance with the invention, a card holder needs to carry just one card for all card uses, both financial and non-financial. (Taylor, Abstract.)

Pages 6 and 7 of the Official Action cite Taylor, col. 2, lines 1-10 for a teaching of tracking/storing a user's purchase history. However, Taylor relates to replacing a plurality of credit/debit cards with a single smart card for tracking/storing a user's purchase history for upkeep of the credit or debit account and automatic tracking of bonus points, award discounts, or coupon equivalents automatically depending upon current purchases and/or history of purchase, broken down by brand and in other ways. (Taylor, col. 1 line 54 to col. 2 line 12.) The use of a smart credit or debit card for moving closer to a so-called cashless society as disclosed in Taylor relates to a substantially different environment and problem than the applicant's wireless communications system and problem of selecting and delivering advertisements targeted to the wireless communication devices depending on the geographic locations of the wireless devices and certain locations of interest to the users of the wireless devices.

With respect to claim 79 in particular, page 5 of the Official Action notes that Hidary discloses an example of a subscriber having a four year old car, and the message may be an advertisement from a local car dealer for a new car, but Hidary is silent on including history of purchases made by the user of the wireless communication device. In applicant's view, it is

unreasonable to interpret the applicant's "history of purchases" so broadly as to be disclosed by the mere fact that a subscriber has a four year old car. There is no disclosure in History of how or when the user of the wireless communication device came into possession of the four year old car. In applicant's view, a "history of purchases" requires a record of more than one purchase, and each record must identify at least what was purchased and when the purchase occurred. In a similar fashion, Owensby's disclosure of "Historical Response Data relating to the responses made to the targeted messages previously provided to the subscriber" (col. 1 lines 28-30; col. 5 lines 40-44; col. 6 lines 1-26) does not detail records of what was purchased and when the purchases occurred.

In view of the above, it is respectfully submitted that the application is in condition for allowance. Reconsideration and early allowance are earnestly solicited.

Respectfully submitted,

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